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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/692,747	10/18/2000	Craig L. Ogg	39478/RRT/S850	7075
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23363 7590 05/18/2006

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EXAMINER
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HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/692,747

Applicant(s)

OGG ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Status of Claims***

1. Claims 1-45 have been examined.

***Response to Amendments/Arguments***

2. Regarding claims 1 and 29, Applicant recites a secret key “for identifying”, a server system “capable of communicating” over a network “for receiving user information and a secret key”, a user interface “to inform”, and a user interface “for requiring the user to re-register”. It has been held that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)). Claims 1 and 29 also recite conditional language (“if” language), however, language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP 2106 II C).

Claims 1, 16, 29 and 37 recite a re-registration interface that requires a user to re-register. On the other hand, these claims also provide the user with an option for re-registering. Therefore, it is not clear to one of ordinary skill how Applicant’s claimed method and system is to perform the task of “re-registering”

as a process cannot be both required and optional (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)). For example, if the user opts not to re-register then Applicant's "requiring" step does not occur.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 16, 29 and 37 recite a re-registration interface that requires a user to re-register. On the other hand, these claims also provide the user with an option for re-registering. Therefore, it is not clear to one of ordinary skill how Applicant's claimed method and system is to perform the task of "re-registering" as a process cannot be both required and optional (*In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)).

For purposes of examination, Applicant's "informing" and "requiring" steps are being interpreted as "informing the user that the user is already registered on the first computer", as the steps of optional re-registration and requiring re-registration are mutually exclusive events.

Claims 2-15, 17-28, 30-36 and 38-45 are also rejected as they depend from claims 1, 16, 29 or 37.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5, 7-19, 21-31, 33-30 and 41-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia, U.S. Patent No. 6,009,177.

As per claims 1-5, 7-19, 21-31, 33-30 and 41-45, Sudia teaches a digital communications security system comprising:

- a user using one or more computers (column 1, lines 20-58; column 2, lines 55-63; column 13, lines 30-63; column 16, lines 9-34; column 21, lines 15-53)
- a secret key for identifying a first computer and registering a user
- a remote system that communicates with one or more user computers and receives user information and a secret key for registering a user (i.e. registering a user with an online system) (column/line 17/29-18/11)

- a user that uses said first computer for second and subsequent communications with the remote system (column 21, lines 15-53)
- a secret key that comprises an encrypted randomly generated hash message authentication key that is generated at the time of registration (column/line 17/50-18/11; column 25, lines 27-51)
- a secret key that comprises an encrypted randomly generated hash message authentication key for digitally signing electronic communications thereby authenticating the user, storing said key at the user computer and changing said key at periodic intervals (column 15, lines 45-58; column 17, lines 37-48 and 55-64; column 21, lines 40-54; column 41, lines 15-43)

Sudia also discloses informing a user that the user is registered on the first computer because the computer will not encrypt or decrypt unless the user's certificate is present on the computer (column 17, lines 50-55; column 20, lines 25-61; column 21, lines 15-20). Thus, the fact that the user can perform encrypted communications sufficiently teaches Applicant's "informing". Similarly, if a user attempts to use another computer on which the user is not registered, "rekey", or the certificate is no longer valid the second computer allows the user to register or re-register (column 17, lines 50-55; column 20, line 53; column 41, lines 15-30). Sudia does not explicitly recite the type of keys used. However, as

Sudia recites symmetric key encryption (shared key), encryption using session keys, asymmetric encryption (public/private or secret keys used for decryption/encryption or encryption/decryption), the specific methods of Diffie-Hellman, RSA, Micali, DES, etc. It would have been at least obvious for one of ordinary skill to choose any of the disclosed methods by Sudia to enable to parties to communicate cryptographically.

Limitations identifying the type of VBI used or system with which a user is registering is merely non-functional descriptive material and, non-functional descriptive material cannot render non-obvious an invention that would have been otherwise been obvious (In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983).

Regarding postal security devices, the teachings of Sudia are broadly applied to trusted devices that comprise an embedded microprocessor, input-output interface, memory and optionally a cryptographic co-processor (column 13, lines 30-63). A PSD is an element of the set of "trusted devices" as it comprises the features identified above. In addition, PSD's print "value bearing instruments" (VBI). Therefore, it would have been obvious to one of ordinary skill to apply the teachings of Sudia to trusted devices such as PSDs.

Sudia does not explicitly recite user computers communicating with a system that is a server system. However, Sudia teaches a user first computer communicating with another user computer (column 21, lines 27-29), securing

digital communications (column 2, lines 55-63) and distributed data processing systems such as those used for distributing electronic mail (column 1, lines 20-40), hence, it is at least obvious to one of ordinary skill for the user computer to communicate with the escrow agent computer system (i.e. remote system) over computer network (figures 15 and 16) such as the internet.

7. Claims 6, 20, 32, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia, U.S. Patent No. 6,009,177 in view of Ote et al., U.S. Patent No. 6,023,506.

As per claims 6, 20, 32, and 40, Sudia teaches a digital communications security system that uses encryption keys for encrypted user computer specific information such as a secret key comprising an encrypted randomly generated hash message authentication key that is generated at the time of registration (column/line 17/50-18/11; column 25, lines 27-51). However, Sudia does not explicitly recite a specific encryption method for encrypting the user computer specific information. Ote et al. teach a method for generating an encryption key using a user pass-phrase (abstract). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Sudia and Ote et al. in order to reduce the burden on users regarding the management of encrypting information ('506, column/line 1/65-2/6).



***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Purpura teaches a user registering with a first computer then re-registering with a second computer using logging onto

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

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Washington, D.C. 20231

or faxed to:

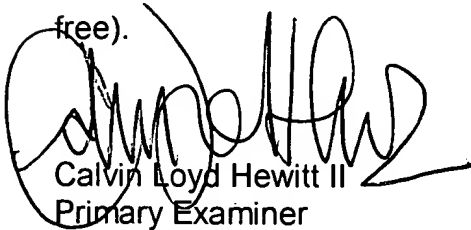
(571) 273-8300 (for formal communications intended for entry and after-final communications),

or:

(571) 273-6709 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).



Calvin Lloyd Hewitt II  
Primary Examiner

May 3, 2006